

REMARKS:

Claims 1-29 are pending in the present application as of the filing of this Amendment. Claims 1-10 stand rejected under 35 U.S.C. § 103(a) over MAPICS software in view of U.S. Patent No. 6,115,690 to Wong ('Wong'). Claims 11-13 stand rejected under 35 U.S.C. § 103(a) over MAPICS software in view of Wong, further in view of DataMirror's software. The Office Action indicates that claims 14-29¹ "recite limitations addressed by the rejection of Claims 1-13 above, therefore the same rejection applies." (Office Action, page 15, lines 17-18)

By this Amendment, claims 1, 11-14, and 21 are hereby cancelled without prejudice. Thus, upon entry of this Amendment, claims 2-10, 15-20, and 22-29 are pending.

Also by this Amendment the specification has been amended to update the cross-reference statement to include the serial number of the related application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

By this Amendment, claims 1, 11-14, and 21 have been cancelled. Thus, the rejections of claims 1, 11-14, and 21 are considered moot.

Claims 2-10 stand rejected under 35 U.S.C. § 103(a) over MAPICS software in view of Wong. The Office Action relies on the disclosure of the following documents as being descriptive of MAPICS software, and thus a basis for the present rejection:

Reference A: Web.archive.org's MAPICS.com webpage titled "technology AS/400e"
Reference B: Web.archive.org's MAPICS.com webpage titled "Future Directions"
Reference C: Web.archive.org's MAPICS.com webpage titled "Products Overview"
Reference D: Web.archive.org's MAPICS.com webpage titled "Products Demand"
Reference E: Web.archive.org's MAPICS.com webpage titled "Resource Planning"
Reference F: Bruce Wassells www-919.ibm.com webpage titled "MQSeries for AS/400 V5.1"

¹ The Office Action actually states "claims 14-19." However, during a telephone call with Examiner Sterrett on April 28, 2005, the Examiner stated that the "19" is a typographical error, and instead should be a "29."

Reference G: Web.archive.org's MAPICS.com webpage titled "MAPICS XA Product Family"

Claim 4 has been amended to independent form, and claims 2, 3, and 5-10 depend from claim 4 as a result of amendments made herein. Because the proposed combination of MAPICS software and Wong fails to disclose or suggest all of the limitations of claims 2-10, these claims cannot be rendered obvious by the proposed combination of MAPICS software and Wong.

Specifically, claim 4 as amended recites:

A high availability planning and scheduling system, comprising:
a plurality of high availability (HA) systems coupled to one or more external systems using a message bus, each HA system including:
an HA server operable to receive and queue requests received from the external systems; and
an advanced planning and scheduling (APS) engine operable to:
receive a request from the HA server;
process the request using planning information stored in memory of the HA system;
modify the planning information according to the processing of the request; and
generate a response to the external system from which the request originated; and
a message manager operable to direct each request received from an external system to an appropriate HA system using the message bus, wherein:
the plurality of HA systems comprise:
a primary HA system operable to process requests requiring modification of the planning information; and
one or more secondary HA systems operable to process requests not requiring modification of the planning information; and
the message manager is operable to:
direct requests received from external systems and requiring modification of the planning information to the primary HA system;
and
direct requests received from external systems and not requiring modification of the planning information to one of the secondary HA systems.

(Emphasis added) The Office Action concedes that MAPICS software does not teach all of the limitations of claim 4:

MAPICS does not teach:
direct requests received from external systems and requiring
modification of the planning information to the primary HA system; and
direct requests received from external systems and not requiring
modification of the planning information to one of the secondary HA
systems.

(Office Action, page 8, lines 3-7) While claim 4 is rejected over the combination of MAPICS software and Wong, the Office Action does not rely on the teachings of Wong for supplementing the teachings of MAPICS software for alleging that the above limitations are obvious. Instead, the Office Action indicates that Official Notice is taken:

The examiner takes Official Notice that it is old and well known in the art of queuing theory to direct different kinds of requests, including those requiring modification of planning information and those not requiring modification of planning information, to various systems in order to balance workload information and in accordance with the priority of the particular request.

(Office Action, page 8, lines 8-12) Applicant hereby traverses the Official Notice because the asserted facts are not supported by documentary evidence and appear to be based on opinions formulated using the present application as a template, which constitutes impermissible use of hindsight.

'Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While 'official notice' may be relied upon, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy

the dispute(citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” MPEP § 2144.03(A) (emphasis in original).

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03(A) (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Thus, if the Examiner continues to maintain the rejection of the claims based on the Official Notice, the Applicant requests that the Examiner provide documentary evidence as stated in Section 2144.03 of the M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See MPEP § 2144.03(C)).

For at least these reasons, Applicant respectfully requests reconsideration and allowance of claim 4, and claims 2, 3, 5-10 depending from claim 4.

Independent claims 15, 22, 28, and 29 recite limitations similar to those discussed above in connection with claim 4, and are therefore considered allowable for the same reasons discussed above in connection with claim 4. Since claims 16-20 depend from claim 15, and claims 23-27 depend from claim 22, these claims are considered allowable for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 2-10, 15-20, and 22-29 are not rendered obvious by the proposed combination of MAPICS software and Wong. The Applicant further submits that claims 2-10, 15-20, and 22-29 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 2-10, 15-20, and 22-29 be reconsidered and that claims 2-10, 15-20, and 22-29 be allowed.

The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any

motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

No fees are believed to be incurred by the filing of this Amendment. However, if a fee should be required, the Director is hereby to charge any such fee to Deposit Account No. **500777**. If an extension of time is required If there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Petition for Extension of Time should be charged to Deposit Account No. **500777**.

Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.

Respectfully submitted,

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